UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,007	10/17/2000	Harry W. Morris	06975-058001 / Ad Serving	1832

			EXAMINER
26171	7590	02/06/2004	PHAN, TAM T

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ART UNIT	PAPER NUMBER
2144	11

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	**Applicant(s)**
Office Action Summary		09/690,007	MORRIS ET AL.
		Examiner	**Art Unit**
		Tam (Jenny) Phan	2144

-- The MAILING DATE of this communication appears on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 March 2003_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-28 and 55-57_ is/are pending in the application.

　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-28 and 55-57_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _17 October 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

　a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _5_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ____ .

DETAILED ACTION

1.   Claims 1-28 and 55-57 remain pending.

Election/Restrictions

2.   Applicant's election without traverse of Group I (claims 1-28 and 55-57) in Paper No. 10 is acknowledged.

3.   Claims 29-54 and 58-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made **without** traverse in Paper No. 10.

4.   Examiner is appreciative of the courtesy shown by Applicant in discussions of this restriction requirement.

Priority

5.   This application claims benefit of the provisional application 60/195991 (04/07/2000).

6.   The effective filing date for the subject matter defined in the pending claims, which has support in parent 60/195991 in this application, is 04/07/2000. Any new subject mater defined in the claims not previously disclosed in parent 60/195991, is entitled to the effective filing date of 10/17/2000.

Information Disclosure Statement

7.   An initialed and dated copy of Applicant's IDS form 1449, Paper No. 5, is attached to the instant Office action.

Drawings

8.   This application has been filed with informal drawings, which are acceptable for

examination purposes only. Formal drawings will be required when the application is

allowed.

Claim Rejections - 35 USC § 101

9.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 15-28 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter of a "program per se" not tangibly embodied on

a computer readable medium. Programs per se are not patentable.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 1-28 and 55-57 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Middleton et al. (WO 99/13423, hereinafter referred to as Middleton

in view of Guyot et al. (U.S. Patent Number 6,119,098).

12.   Regarding claim 1, Middle disclosed a method of presenting advertising to

viewers in a computer network environment (Title, Abstract), the method comprising:

monitoring a viewer's interactions with an associated computer system (Title, Abstract,

page 3 lines 26-31, claim 1).

13.   Middleton taught the invention substantially as claimed, however, Middleton did

not expressly teach a method of adjusting a timing of displayed advertisements on the

viewer's associated computer system based on one or more of the viewer's monitored

interactions.

14.   Middleton suggested exploration of art and/or provided a reason to modify the

method of presenting advertisement to include a step of adjusting timing (page 10 lines

4-15).

15.   Guyot disclosed a method of adjusting a timing of displayed advertisements on

the viewer's associated computer system based on one or more of the viewer's

monitored interactions (Title, column 2 lines 9-20).

16.   Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to modify the advertisement method of Middleton with

the teachings of Guyot to include a step of adjusting timing in order to effectively

present the advertisement to users (Middleton, page 13 lines 1-3) since when the user

is performing other activities on the computer, the probability of viewing an

advertisement is relatively low (Guyot, column 1 lines 34-43).

17.   Regarding claim 2, Guyot disclosed a method wherein adjusting the timing

comprises adjusting an ad expiration tuning parameter configured to set the quantity of

time for which an advertisement is available for display (column 2 lines 9-13, column 4

lines 34-43, column 7 lines 1-6).

18.   Regarding claim 3, Guyot disclosed a method wherein adjusting the timing

comprises adjusting a maximum display count configured to set a maximum number of

times an advertisement may be displayed to a user viewing a batch of ads (column 2 lines 9-13, column 4 lines 34-43, column 7 lines 1-6).

19.   Regarding claim 4, Guyot disclosed a method wherein adjusting the timing comprises adjusting a minimum display time configured to set a minimum amount of time that an advertisement may be displayed before another advertisement is displayed (column 2 lines 9-13, column 4 lines 34-67).

20.   Regarding claim 5, Guyot disclosed a method wherein adjusting the timing comprises adjusting an idle delay configured to cause a delay from the time a user has gone idle before a first advertisement is replaced with another advertisement (column 5 lines 6- 17, column 7 lines 49-56).

21.   Regarding claim 6, Guyot disclosed a method wherein adjusting the timing comprises adjusting an active delay configured to cause a delay from the time a user goes active before displaying another advertisement (column 5 lines 6- 17, column 7 lines 49-56).

22.   Regarding claim 7, Guyot disclosed a method wherein adjusting the timing comprises adjusting an idle (no spin) parameter configured to stop the display of a first advertisement from being replaced with the display of another advertisement after a user goes idle (column 5 lines 6- 17, column 7 lines 49-67).

23.   Regarding claim 8, Middleton disclosed a method wherein monitoring a viewer's interactions with an associated computer system comprises monitoring a use of a computer mouse (Abstract, pg 3 lines 25-31, page 8 lines 20-24).

24.   Regarding claim 9, Middleton disclosed a method wherein monitoring a viewer's interactions with an associated computer system comprises monitoring a use of a computer keyboard (Abstract, pg 8 lines 20-24).

25.   Regarding claim 10, Guyot disclosed a method wherein monitoring a viewer's interactions with an associated computer system comprises monitoring the activity of any input devices connected to the subscriber system [an auditory signal such as the viewer's voice provided through a microphone] (column 7 lines 63-67, column 8 lines 1-1-4).

26.   Regarding claim 11, Guyot disclosed a method wherein the auditory signal is the viewer's voice (column 7 lines 63-67, column 8 lines 1-1-4).

27.   Regarding claim 12, Guyot disclosed a method wherein monitoring a viewer's interactions with an associated computer system comprises monitoring a maximization and a minimization status of a screen displaying advertising (column 2 lines 19-13, column 5 lines 6-11, lines 45-61).

28.   Regarding claim 13, Middleton disclosed a method wherein monitoring a viewer's interactions with an associated computer system comprises monitoring a viewer's use of a device that sends an input, or causes an input to be sent, to the associated computer system (pg 4 lines 3-8, lines 15-21, page 12 lines 1-7).

29.   Regarding claim 14, Guyot disclosed a method wherein the timing of displayed advertisements on a screen displaying advertising is configured to not switch between advertisements if the screen displaying advertisements is minimized or occluded (column 5 lines 6-11, lines 45-61, column 12 lines 46-56).

30.   Regarding claims 15-28, the system corresponds directly to the method of claim

1-14, and thus these claims are rejected using the same rationale.

31.   Regarding claim 55, Middleton disclosed a method of optimizing a click-through

rate of a user viewing content in a computer network environment (Title, Abstract), the

method comprising: providing advertisements (Title, Abstract, page 3 lines 25-31, page

4 lines 3-8). Guyot disclosed steps of providing a set of tuning parameters configured to

cause a display of a first advertisement on a user's computer to be changed to a display

of another advertisement on the user's computer based on the user's activity with

respect to the user's computer (Abstract, Figure 5, column 2 lines 8-19); downloading

the advertisements and tuning parameters to the user's computer (Figure 6B, column 4

lines 34-67, column 7 lines 49-57, column 13 lines 14-35); storing click-through

information for the advertisements (column 3 lines 55-65, column 4 lines 16-23); and

sending the click-through information to a host computer (column 4 lines 16-23, column

6 lines 51-63).

32.   Regarding claim 56, Middleton disclosed a method further comprising varying the

tuning parameters downloaded to the user's computer (column 4 lines 34-67); and

utilizing a correlation technique to determine a correlation between the tuning

parameters downloaded to the user's computer and the click-through rate of the user

(column 6 lines 51-63, column 10 lines 11-22).

33.   Regarding claim 57, Middleton disclosed a further comprising setting another set

of tuning parameters based on the correlation between the tuning parameters and the

user's click-through rate (column 4 lines 34-67, column 6 lines 51-63, column 10 lines

11-22).

34.   Since all the limitations of the claimed invention were disclosed by the

combination of Middleton and Guyot, claims 1-28 and 55-57are rejected.

Conclusion

35.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

      a.   Schena et al. (U.S. Patent Number 5,946,646) disclosed an interactive

advertisement system and device to monitor user activity. When the user

workstation is idle for a specified period of time, a screen show will display

advertisements. In the pre-interactive mode, the advertiser controls the frequency

of the display and the length of the display. In an interactive format, the

advertiser controls the length of display and the target user.

      b.   Rakavy et al. (U.S. Patent Number 5,913,040) disclosed a method and

apparatus for presenting advertisement. The advertisements are made attractive

to the user by employing a variety of video, animation, sound or any other

multimedia effect. The system monitors the user's interactions and the user

preference and advertisement database stores information such as identification

of the user's natural language. Local configuration data typically includes screen

saver delay time.

      c.   Cezar (U.S. Patent Number 6,128,651) disclosed an Internet advertising

system with controlled and timed display of ad content from centralized system

controller. The system uses the browser in a scheme of precise timed ad display

control. The browser initiates timer running as each ad is displayed. Thus, the

advertiser is assured that his particular ad content is displayed for the required

minimum time interval.

36.   Refer to the enclosed PTO-892 for details and complete listing of other pertinent

prior art of record.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tam (Jenny) Phan whose telephone number is (703)

305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 746-7239

for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

Jack Harvey
SPE
Art Unit 2142
703-305-9705

tp
February 4, 2004

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER